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DfW Jun-08

Paper No. 8

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**COPY MAILED**

**JUN 26 2008**

**OFFICE OF PETITIONS**

In re Application of :  
Fleury et al. : DECISION ON PETITION  
Application Number: 09/083180 :  
Filing Date: 05/22/1998 :  
Attorney Docket Number: :  
612.36255X00 :

This is a decision in reference to the "RECONSIDERATION OF DISMISSAL OF PETITION DATED FEBRUARY 13, 2008," filed on March 13, 2008, which is treated as a petition to withdraw the holding of abandonment.

The petition is again **DISMISSED**.

This application was held abandoned for failure to timely file a response to the Notice to File Missing Parts of Application mailed on June 9, 1998, which set a two (2) month shortened period for reply. On July 9, 1999, Notice of Abandonment was mailed. The petition filed on January 25, 2008, was dismissed on February 13, 2008.

Petitioners again request, in essence, that the holding of abandonment be withdrawn. Petitioners assert, in pertinent part:

The undersigned is not aware of any rule requiring diligence in responding to the failure of the Office to properly process the Applicants' Responses to Notice of Abandonment of August 5, 1999, and October 7, 2005. Neither M.P.E.P. Sections § 203.08 or 503 requires a showing of diligence for the revival of an abandoned application predicated upon a showing that a U.S. PTO communication was never received.

Petitioners' argument has been considered, but is not persuasive.

At the outset, petitioner's assertion that diligence is not required on the part of the applicant with respect to the handling of the application is not well taken. The prosecution of the application is the responsibility of the applicant, not the Office, and petitioner is required to show diligence in prosecution of the application.<sup>1</sup>

Additionally, while the general Office policy under MPEP 508.03 is that if a paper having an incorrect serial number contains sufficient information to identify the correct application and was timely received at the Office, the Office is not required to consider papers filed with incorrect application numbers as timely filed. In this case, the response asserted to have been originally filed, the original petition to withdraw the holding of abandonment, and the postcard accompanying the petition to withdraw the holding of abandonment each miscaptioned the application number. The applicant assumes the risk, when the application number is incorrect, that the papers will not be matched with the correct application.

Still further, MPEP 503 requires an itemized postcard including the application number. As the postcard itemizing the filing of the petition to withdraw the holding of abandonment filed on August 5, 1999, contains the wrong serial number, the showing of record is that the petition to withdraw the holding of abandonment was filed in Application No. 08/083,180. No petition to withdraw the holding of abandonment was timely filed in Application No. 09/083,180.

As such, the petition is again dismissed, however, under the circumstances, such dismissal is without prejudice to consideration of a petition under 37 CFR 1.137(a), to revive the application where the delay in filing a response was unavoidable. Petitioners may wish to consider filing a petition under 37 CFR 1.137(a), accompanied by the proper fee.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. **This period may not be extended.**<sup>2</sup>

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<sup>1</sup> See Douglas v. Manbeck, 21 U.S.P.Q.2d 1697 (E.D. Pa. 1991).

<sup>2</sup> 37 CFR 1.181(f).

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (571) 273-8300  
                  Attn: Office of Petitions

By hand:           Customer Service Window  
                  Mail Stop Petition  
                  Randolph Building  
                  401 Dulany Street  
                  Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

Encl:           PTO/SB/61

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<b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)</b>	<b>Docket Number (Optional)</b>
<div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p>First Named Inventor: _____</p> <p>Application Number: _____</p> <p>Filed: _____</p> <p>Title: _____</p> </div> <div style="width: 45%;"> <p>Art Unit: _____</p> <p>Examiner: _____</p> </div> </div> <p>Attention: Office of Petitions  <b>Mail Stop Petition</b>          Commissioner for Patents          P.O. Box 1450          Alexandria, VA 22313-1450</p> <p style="text-align: center;">NOTE: If information or assistance is needed in completing this form, please contact          Petitions Information at (571) 272-3282.</p> <p>The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.</p> <p style="text-align: center;"><b>APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.</b></p> <p>NOTE: A grantable petition requires the following items:</p> <ol style="list-style-type: none"> <li>(1) Petition fee.</li> <li>(2) Reply and/or issue fee.</li> <li>(3) Terminal disclaimer with disclaimer fee – required for all utility and plant applications filed before June 8, 1995, and for all design applications; and</li> <li>(4) Adequate showing of the cause of unavoidable delay.</li> </ol> <p><b>1. Petition fee</b></p> <p><input type="checkbox"/> Small entity – fee \$ _____ (37 CFR 1.17(l)). Applicant claims small entity status.          See 37 CFR 1.27.</p> <p><input type="checkbox"/> Other than small entity – fee \$ _____ (37 CFR 1.17(l)).</p> <p><b>2. Reply and/or fee</b></p> <p><b>A</b> The reply and/or fee to the above-noted Office action in the form of _____ (identify the type of reply):</p> <p><input type="checkbox"/> has been filed previously on _____</p> <p><input type="checkbox"/> is enclosed herewith.</p> <p><b>B</b> The issue fee of \$ _____</p> <p><input type="checkbox"/> has been filed previously on _____</p> <p><input type="checkbox"/> is enclosed herewith.</p>	

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This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

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# **PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)**

## **3. Terminal disclaimer with disclaimer fee**

- ☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

## **4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.**

### **WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date

\_\_\_\_\_  
Typed or printed name

\_\_\_\_\_  
Registration Number, if applicable

\_\_\_\_\_  
Address

\_\_\_\_\_  
Telephone Number

\_\_\_\_\_  
Address

Enclosure ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unavoidable delay

☐ \_\_\_\_\_

### **CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Typed or printed name of person signing certificate

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

**NOTE:** The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date

\_\_\_\_\_  
Typed or printed name

\_\_\_\_\_  
Registration Number, if applicable

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply.)

*(Please attach additional sheets if additional space is needed.)*

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.